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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 09/399,578 | 09/20/1999 | DANIEL L. MARKS | AIS-P99-1 | 2427 |
| 7590 PETER K TRZYNA P.O.BOX 7131 CHICAGO, IL 606807131 | | 01/09/2008 | EXAMINER WINDER, PATRICE L | |
| | | | ART UNIT 2145 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/399,578

Applicant(s)

MARKS, DANIEL L.

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8-15-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-291,299,309-366,376-502,504-519,521-536,538-553,555-570,572-590 and 592-995.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 169,409,599,632-725,755-817,862-875,879,893-896,901-903,910,917,918,949-952 and 977.

Continuation of Disposition of Claims: Claims rejected are 1-168,170-291,299,309-366,376-408,410-502,504-519,521-536,538-553,556-570,572-590,592-598,600-631,726-754,818-861,876-878,890-892,897-900,904-909,911-916,919,948,953-976 and 978-995.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2007 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed August 15, 2007 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. (The copy submitted is not legible).

Response to Claim Charts

3. The examiner thanks Applicant for the claim tree mapping the claim organization. Applicant's time and effort are greatly appreciated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-168, 170-291, 299, 309-366, 376-408, 410-502, 504-519, 521-536, 538-553, 556-570, 572-590, 592-598, 600-631, 726-754, 818-861, 876-878, 890-892, 897-900, 904-909, 911-916, 919, 948, 953-976 and 978-995 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al., USPN 5,941,947 (hereafter referred to as Brown) in view of Tang et al., USPN 5,793,365 (hereafter referred to as Tang). [claim 1] Brown taught a method of communicating via an Internet network (abstract), the method including:

connecting a plurality of computers to a computer system, each of the plurality of computers connected to a respective input device and to respective output device (microcomputer 102, column 8, lines 47-53);

determining whether a first of the user identities and a second of the user identities are able to form a group for sending and receiving communications in real time (chat rooms, column 9, lines 45-50; column 10, lines 36-45; column 13, lines 9-14; column 16, lines 2-4);

determining whether at least one of the first user identity and the second user identity, individually, is censored from data representing a content object (column 16, lines 55-66); and

if the first and the second user identities are able to form the group, forming the group for sending the communications, and receiving the communications that are not censored based on the individual user identity (column 13, lines 52-54), when the receiving is in real-time and via the Internet, and not presenting the data that is censored to the corresponding output device (column 15, lines 27-37). Brown does not specifically teach the content object is a pointer, video, audio, a graphic, or multimedia. However, Tang taught the content object is a pointer, video, audio, a graphic, or multimedia (column 9, lines 38-44, 51-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Tang's multimedia content in Brown's chat service would have improved the chat room experience. The motivation would have been to improve the chat room experience by allowing the participants to share files.

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[claims 2-17] Brown taught determining whether at least one of the first user identity and the second user identity, individually, is censored from data (column 16, lines 2-4, 55-59). Tang taught representing [a pointer, video, audio, a graphic, multimedia]. (column 9, lines 38-55)

[claims 18-34] Brown taught at least some of the communications include at least one of text or ascii (column 9, lines 52-54).

[claims 35-51] Brown taught determining whether at least one of the first user identity and the second user identity, individually, is censored from sending in the communications data representing a content object (column 15, lines 44-54) and sending the data that is not censored from sending (column 15, lines 5-15). Tang taught the content object is at least one of a pointer, video, audio, a graphic, or multimedia (column 9, lines 38-55).

[claims 52-68] Brown taught determining whether at least one of the communications is censored based on content (column 16, lines 40-45).

[claims 69-74] Brown taught determining a user age corresponding to each of the user identities (user age < 18, column 19, lines 9-21).

[claims 75-85] Brown taught the determining whether at least one of the first user identity and the second user identity, individually, is censored from data includes determining whether a parameter corresponding to the first user identity has been determined by an other of the user identities (column 16, lines 40-45, 55-66).

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[claim 86-102] Brown taught the determining whether the first of the user identities and the second of the user identities are able to form a group includes determining whether the first of the user identities is censored (column 20, lines 8-27).

[claim 103-119] Brown taught determining a user age corresponding to each of the user identities (user age < 18, column 19, lines 9-21).

[claim 120-137, 149-155, 161-163, 166-169] Brown taught the pointer is a pointer that produces a pointer-triggered message on demand (column 10, lines 36-38; column 13, lines 52-54).

[claim 138-148, 156-160, 164] Brown taught the data that is censored from sending represents a pointer that produces a pointer-triggered message on demand (column 10, lines 36-38; column 13, lines 52-54).

[claim 170] Brown taught a method of communicating via an Internet network, the method including:

connecting a plurality of computers to a computer system (column 8, lines 47-53);

sending, from each of the plurality of computers, a respective login name corresponding to respective user identities and a second identities are able to form a group for sending and for receiving communications in real time (chat rooms, column 10, lines 36-45; column 13, lines 9-14; column 16, lines 2-4);

determining whether at least one of the first user identity and the second user identity,, individually, is censored from sending data in the communications, the data representing a content object (column 16, lines 55-66); and

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if the first and second user identities are able to form the group, then forming the group, sending the communications that are not censored based on the individual user identity (column 13, lines 52-54), and receiving the communications, wherein the receiving is in real-time and via the Internet network (column 15, lines 27-37). However, Tang taught the content object is at least one of a pointer, video, audio, a graphic or multimedia (column 9, lines 38-44, 51-55). For motivation see claim 1, above. Brown does not specifically teach the logon procedure includes a password. However, "official notice" is taken that passwords are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating a password in Brown's logon procedure would have been

[claim 171-184] Brown taught the pointer is a pointer that produces a pointer-triggered message on demand (column 10, lines 36-38; column 13, lines 52-54).

[claim 185] Tang taught receiving the communications includes causing presentation of some of the communications by one of the plurality of computer in the group (column 9, lines 30-36).

[claim 186] Brown taught when the communications are censored, not receiving the communications that are censored based on the individual user identity (column 15, lines 44-55), and not presenting the data that is censored to the corresponding output device (column 15, lines 5-15).

[claim 187,309] Brown taught the computer system is comprised of an Internet service provider computer system (column 7, lines 18-37).

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[claim 188,310] Brown taught storing, for the first user identity, an authorization associated with presentation of graphical multimedia (column 16, lines 55-62); and based on the authorization, presenting the graphical multimedia at the output device corresponding to the second user identity (column 16, lines 63-67).

[claim 189,311] Tang taught providing the first user identity with access to a member-associated image corresponding to the second user identity (column 5, lines 18-23).

[claim 190,312] Brown taught determining whether the first user identity is censored from access to a chat room; if the first user identity is censored, not allowing access to the chat room; and if the first user identity is not censored, allowing access to the chat room (column 27 , lines 49-58). Tang taught associating a chat room with a member-associated image corresponding to the second user identity (column 5, lines 18-23).

[claim 191-206] determining whether at least one of the first identity and the second user identity, individually, is censored from sending a content object (column 15, lines 5-15, 44-54). Tang taught the content object is at least one of a pointer, video, audio, a graphic, or multimedia (column 9, lines 38-55).

[claims 207-223] Brown taught at least some of the communications include at least one of text or ascii (column 9, lines 52-54).

[claims 224-240] Brown taught determining whether at least one of the communications is censored based on content (column 16, lines 40-45).

[claim 241-257] Brown taught the determining whether the first of the user identities and the second of the user identities are able to form a group includes determining whether the first of the user identities is censored (column 20, lines 8-27).

[claim 258-274] Brown taught determining a user age corresponding to each of the user identities (user age < 18, column 19, lines 32-41).

[claim 276-291] Brown taught at least one of the communications includes data representing a human communication of sound (voice capability is added, column 9, lines 54-55).

[claim 313-366, 376-379] Brown taught the pointer is a pointer that produces a pointer-triggered message on demand (column 10, lines 36-38; column 13, lines 52-54).

[claim 380-396] Tang taught data representing at least one of a pointer, video, audio, a graphic, or multimedia (column 9, lines 38-55).

[claim 397-408, 410-413] Brown taught determining whether at least one of the communications is censored based on content (column 16, lines 40-45).

[claims 414-430] determining whether at least one of the first user identity and the second user identity, individually, is censored from sending in the communications data representing at least one of a pointer, video, audio, a graphic, or multimedia; and sending the data that is not censored from sending.

[claims 431-434] Brown taught at least some of the communications include at least one of text or ascii (column 9, lines 52-54).

7. Claims 435- 502, 504-519, 521-536, 538-553, 556-570, 572-590, 592-598, 600-631, 726-754, 818-861, 876-878, 890-892, 897-900, 904-909, 911-916, 919, 948, 953-976 and 978-995 are rejected on the same rationales as 1-168, 170-291, 299, 309-366, 376-408, 410-434, above.

Response to Arguments

8. Applicant's arguments with respect to claims 1-168,170-291,299,309-366,376-408,410-502,504-519,521-536,538-553,556-570,572-590,592-598,600-631,726-754,818-861,876-878,890-892,897-900,904-909,911-916,919,948,953-976 and 978-995 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

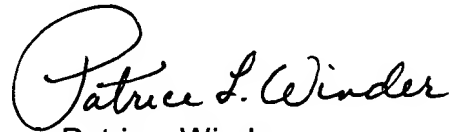
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Patrice L. Winder". The signature is written in a cursive style with a large, looping initial "P".

Patrice Winder
Primary Examiner
Art Unit 2145

January 7, 2008